

REMARKS

Claim Amendments

Claims 1, 8, and 15 are amended in this Response to correct matters or form and to include limitations previously recited in claims 2-3, 9-10, and 16-17. As such, claimed 2-3, 9-10, and 16-17 are cancelled in this Response.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claims 1-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action at page 2 states:

4. Claims 1, 8, and 15 recite the limitation, “the email display capability status attributes” in the last limitation of each claim. There is insufficient antecedent basis the limitation in the claim.

Applicants respectfully note in response, however, that claims 1, 8, and 15 are amended in this response so that the limitation “the email display capability status attributes” is changed to “email display capability status attributes.” As such, all claim limitations include the proper antecedent basis. The Office Action at page 2 also states:

5. Claims 1, 8, and 15 recite the limitation, “an availability field, wherein the availability field is a display capability is currently available to receive email...” It is unclear to Examiner what is meant by a display capability being available to receive email, as it is a capability, and not for example, an email account or device.

Applicants respectfully note in response, however, that the claim language identified by the Examiner has been removed by amendment in this Response. In amending the claims of the present application, Applicants do not concede that Applicants’ claims did not satisfy all requirements set forth in the second paragraph of 35 U.S.C. § 112. Rather, the present amendments are made to move prosecution forward in the present case. Because

the claims have been amended as described above, Applicants request that the rejection of claims 1-21 under 35 U.S.C. § 112, second paragraph, be withdrawn.

**Claim Rejections - 35 U.S.C. § 103 Over Shaffer,
Baudoin, Wakabayashi, And Albal**

Claims 1, 4-8, 11-15, and 18-21 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Shaffer, et al. (U.S. Patent No. 6,092,114) (hereafter, ‘Shaffer’) in view of Baudoin (U.S. Patent No. 5,406,557) (hereafter, ‘Baudoin’) and further in view of Wakabayashi (U.S. Publication 2002/0120699) (hereafter, ‘Wakabayashi’) and Albal, et al. (U.S. Patent No. 6,725,256) (hereafter, ‘Albal’). As discussed above, claims 1, 8, and 15 are amended in this Response to include limitations previously recited in claims 2-3, 9-10, and 16-17. In rejecting claims 2-3, 9-10, and 16-17, the Office Action relies upon Schwalm, et al. (U.S. Patent No. 5,339,361) (hereafter, ‘Schwalm’) as teaching or suggesting limitations introduced by claims 2-3, 9-10, and 16-17 – limitations that are not included in claims 1, 8, and 15.

The question of whether Applicants’ claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a *prima facie* case of obviousness to reject Applicants claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a *prima facie* case of obviousness, the proposed combination of Shaffer, Baudoin, Wakabayashi, Albal, and Schwalm must teach or suggest all of Applicants’ claim limitations. *Manual of Patent Examining Procedure* § 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). As shown below in more detail, the proposed combination of Shaffer, Baudoin, Wakabayashi, Albal, and Schwalm cannot be used to establish a *prima facie* case of obviousness because the proposed combination of Shaffer, Baudoin, Wakabayashi, Albal, and Schwalm does not

teach each and every element of the claims of the present application. The rejection of claims 1, 4-8, 11-15, and 18-21 should therefore be withdrawn and the claims should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1, 4-8, 11-15, and 18-21.

**The Proposed Combination Of Shaffer, Baudoin, Wakabayashi,
Albal, And Schwalm Does Not Teach Or Suggest Each And
Every Element Of Claim 1 Of The Present Application**

To establish a prima facie case of obviousness under 35 U.S.C. § 103 the reference must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 1 of the present application recites:

1. A method of email administration comprising the steps of:

receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain;

receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification and the email display capability status request includes a sender identification identifying the sender, further comprising:

determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain, further comprising:

finding, in dependence upon the sender identification and in dependence upon the domain

identification, at least one sender authorization record, wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain;

the sender authorization record comprises sender authorization attributes including a connection address in the domain; and

finding at least one email display capability record for the domain further comprises finding, in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability status record for the domain;

finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain includes:

a display capability identification;

a display capability description;

a connection type, wherein the connection type is an indication of the protocol or communications technology to be used to send an email or digital objects to client devices;

a connection address, wherein the connection address is an indication of where to send email or digital objects from the transcoding gateway;

a transcode type, wherein the transcode type is an indication whether digital objects in email are to be transcoded in the transcoding gateway or forwarded for further processing elsewhere;

an availability field, wherein the availability field is a status indication of whether a display capability is currently available, including indicating whether a client device or display device is powered off or on; and

a recent usage field, wherein the recent usage field is a status indication of a recent time when a capability was used; and

sending at least one email display capability status attributes to the sender.

As explained in more detail below, the proposed combination of Shaffer, Baudoin, Wakabayashi, Albal, and Schwalm does not teach or suggest each and every element of claim 1 of the present application. Applicants therefore respectfully traverse each rejection individually and request that the rejections be withdrawn.

The Proposed Combination Of Shaffer, Baudoin, Wakabayashi, Albal, And Schwalm Does Not Teach Or Suggest Determining, In Dependence Upon The Sender Identification, That The Sender Is Authorized To Send Email To A Connection Address In The Domain As Claimed In The Present Application

Claim 1 of the present application is amended to include the following limitation previously recited in claim 2 of Applicants' original specification: determining, in

dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain. The Office Action takes the position that Schwalm teaches or suggests this limitation. Applicants respectfully note in response, however, that what Schwalm actually discloses is “a verification mechanism to identify both the sender and recipient of electronic information.” Schwalm at the Abstract. Schwalm further discloses that such verification of “*the identity* of senders and recipients of electronic information on a communication network is accomplished through the use of “spoken voice and/or written signature.” Schwalm at column 2, lines 42-45. Schwalm’s verification mechanism, however, does not teach or suggest determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain as claimed in the present application because Schwalm does not teach or suggest determining that the sender is authorized to send email to a connection address in the domain as claimed here.

In contrast to the claims of the present application, Schwalm is primarily directed to *verifying the identity* of the user. Schwalm discloses that a user can provide verification information in the form of a speech signal or handwriting sample, and that electronic information in a communication network “cannot be sent until the identity of the sender at the respective input device has been verified.” Schwalm at column 3. That is, Schwalm is concerned with confirming that a sender or a recipient is who they say they are – not determining that a sender is *authorized* to send email to a connection address in the domain. Schwalm does make minor mention of a user being “authorized” in Schwalm’s Summary of the Invention, stating that a technical advantage of Schwalm’s system is that Schwalm’s system “ensures only authorized users send and receive electronic information transmissions.” Schwalm at column 2, lines 9-10. Schwalm also briefly references the concept of authentication at the end of Schwalm’s Detailed Description by stating that Schwalm’s system “authenticates to the sender and recipient that each party is authorized to make and receive an electronic information transmission.” The mere mention of the term ‘authorized,’ however, is not enough to teach or suggest determining that a sender is *authorized* to send email to a connection address in the domain as claimed in the present application. In fact, Schwalm never once discloses that

upon verifying the identity of a user, a determination is made that the user is not authorized to send or receive an electronic information transmission. Schwalm's users are always allowed to send or receive an electronic information transmission once the user's identity is confirmed. As such, Schwalm cannot be said to teach or suggest determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain as claimed in the present application.

Even if Schwalm did disclose some method for determining that a sender is authorized to send email to a connection address in the domain, which Schwalm does not disclose, Schwalm cannot be said to disclose the detailed and specific method for determining that the sender is authorized to send email to a connection address in the domain that is claimed in the present application. Claim of 1 the present application recites a very detailed and specific method for determining that a sender is authorized to send email to a connection address in the domain that includes finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record. According to the claimed method, such a sender authorization record represents authorization for the sender to send email to a connection address in the domain. Furthermore, as claimed here, the sender authorization record comprises sender authorization attributes including a connection address in the domain. In addition, the claimed method includes finding at least one email display capability record for the domain further comprises finding, in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability status record for the domain. Interpreting Schwalm as teaching or suggesting the limitations recited above requires reading significantly more into Schwalm than is actually disclosed. Because Schwalm does not teach or suggest the limitations that it is cited against, the proposed combination of Shaffer, Baudoin, Wakabayashi, Albal, and Schwalm cannot be used to establish a *prima facie* case of obviousness within the meaning of 35 U.S.C. § 103. The rejection of claim 1 under 35 U.S.C. § 103 should therefore be withdrawn and claim 1 should be allowed.

Relations Among Claims

Independent claims 8 and 15 are system and computer program product claims for email administration that correspond to independent method claim 1. Claim 1 is allowable for the reasons set forth above. Claims 8 and 15 are allowable because claim 1 is allowable. The rejections of claims 8 and 15 therefore should be withdrawn, and claims 8 and 15 should be allowed. Applicants respectfully request reconsideration of claims 1, 8, and 15.

Claims 4-7, 11-14, and 18-21 depend from independent claims 1, 8, and 15, respectively. Each dependent claim includes all of the limitations of the independent claim from which it depends. For the same reasons that the cited combination of references do not teach and suggest each and every element of independent claims 1, 8, and 15, the cited combination of references also cannot possibly teach or suggest each and every element of any dependent claim. The rejections of claims 4-7, 11-14, and 18-21 should be withdrawn, and these claims also should be allowed. Applicants respectfully request reconsideration of claims 4-7, 11-14, and 18-21.

Claim Rejections - 35 U.S.C. § 103 Over Shaffer, Baudoin, Wakabayashi, Albal, And Schwalm

Claims 2-3, 9-10, and 16-17 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Shaffer, Baudoin, Wakabayashi, Albal, and Schwalm. As discussed above, claims 2-3, 9-10, and 16-17 are cancelled in this Response. As such, Applicants request that the rejections be withdrawn.

Conclusion

Claims 1, 4-8, 11-15, and 18-21 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Shaffer, Baudoin, Wakabayashi, and Albal. For the reasons set forth above, however, the combination of Shaffer, Baudoin, Wakabayashi, Albal, and Schwalm cannot be used to establish a *prima facie* case of obviousness against claims 1,

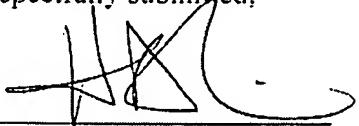
4-8, 11-15, and 18-21 of the present application. The rejection of claims 1, 4-8, 11-15, and 18-21 under 35 U.S.C. § 103 should therefore be withdrawn and the claim should be allowed. Applicants respectfully request reconsideration of claims 1, 4-8, 11-15, and 18-21.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447
for any fees required or overpaid.

Date: January 27, 2009

Respectfully submitted,

By:


H. Artoush Ohanian
Reg. No. 46,022
Biggers & Ohanian, LLP
P.O. Box 1469
Austin, Texas 78767-1469
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS